

REMARKS

In the specification, several paragraphs have been amended to clarify aspects of the present invention and to correct typographical errors, grammatical errors and/or minor editorial problems. None of the foregoing changes add any new matter.

Claims 1-25 stand rejected. Claims 8 and 19 have been amended to overcome the deficiency pointed out by the Examiner. Claims 20, 21 and 22 have been amended to correct inadvertent omissions. None of the foregoing changes involves any new matter. Claims 1-25 are presented for reconsideration.

The Applicant respectfully requests reconsideration of the rejections and objections in view of the above amendments and the following remarks.

In ¶1 of the Office Action, the Examiner rejected claims 8 and 19 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As to claim 8 the Examiner stated that claim 8 "cites 'resuming the interference... after an off-hook condition.' Claim 8 depends from claim 1 and nowhere in claim 1 is it cited that the interference stops, thereby necessitating the need to 'resume' interference or that the telephone is placed on-hook and then taken off-hook." In response, claim 8 has been amended to cure this deficiency. Further, the Examiner stated that claim 19 "recites the limitation 'the remote computer' in line 12. There is insufficient antecedent basis for this limitation in the claim." In response, claim 19 has been amended to cure this deficiency.

In ¶2 of the Office Action, the Examiner rejected claims 1, 2, 4, 5, and 9 to 22 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,864,613 to Flood (hereafter,

"Flood"). The Applicant respectfully traverses this ground of rejection for the reasons set forth below.

As to claim 1 and 4, the Examiner states that Flood teaches a call restriction apparatus known as a call caging system disclosing or teaching all of the limitations of claims 1 and 4 except for converting DTMF signals, which the Examiner alleges "would be at the least obvious to one of ordinary skill on the art to have included in Flood...." The Applicant traverses this ground of rejection for the following reasons.

First, there are limitations in claim 1 that are not disclosed or suggested in Flood. Claim 1 requires "a transceiver having conductors for receiving tone signals from and sending tone signals to the telephone line and conductors for sending digital signals to and receiving digital signals from said controller." The Examiner contends that Flood "teaches that a user may send and receive calls to and from network 108 and send commands to system 100 to enter and modify data in database 106. Therefore, it is inherent that Flood has a transceiver or some analogous means for receiving and transmitting DTMF signals read as the claimed "tone signals." (Col. 2, lines 60 - 67)." (Office Action, p. 3., emphasis added) The Applicant respectfully disagrees.

The section of Flood cited by the Examiner relates to using a telephone to "send commands to switch 104 to enter and modify access criteria stored on database 106." The cited reference, at most, only discloses that Flood has a means for receiving tones (i.e., DTMF signals) from a telephone line. It does not necessarily follow that having a means to receive tones necessarily includes having a means to transmit tones. Further, nothing in the cited section or anywhere else in Flood is there any disclosure or suggestion that the device of Flood has or even requires a means for transmitting tones to a telephone line.

Another limitation of claim 1 is that "said controller is programmed ... to cause interference on said telephone line in response to detection of a call inhibition condition." There is nothing in Flood that discloses such a limitation. The Examiner contends that:

As to the operation of Flood's call caging system 100, the telephone line to and from telephone 102 is monitored for either incoming or outgoing calls and when either an incoming or outgoing number is detected as being one that should be restricted according the rules stored in database 106, system 100 plays a recorded block indication message and then terminates the call, read as the claimed "caus[ing] an interference on said telephone line." (Figs. 4A - 5C. Col. 7, line 19 - Col. 8, line 59).

Office Action, p. 4.

The Examiner has misunderstood the teaching of Flood. In Flood, the call caging system controls access between a telephone and a telephone network by using "a switch, electrically coupled between the telephone and the telephone network, for selectively coupling the telephone and telephone network based on the access criteria stored in the database" (Flood, col. 1, lines 60-65). The switch is a Class 5 switch or a private branch exchange, i.e., PBX. (Flood, col. 3, lines 1-5). In short, in Flood the call caging system does not cause an "interference on said telephone line" but uses the switch to actually uncouple the telephone from the telephone network.

The Applicant also points out that the Examiner has not established a prima facie case of obviousness, based on the three basic criteria set forth at MPEP 706.02(j). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The

teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. The Examiner has not met the first and third criteria.

Since Flood does not disclose, suggest or teach causing interference on a telephone line in response to the detection of a call inhibition condition the Examiner must show some suggestion or motivation, either in the Flood or in the knowledge generally available to one of ordinary skill in the art, to modify the device of Flood to cause an interference on a telephone line in response to the detection of a call inhibition condition. The Examiner has not made reference to any such suggestion or motivation.

Also, Flood and the call restrictor recited in claim 1 take mutually exclusive paths and reach different solutions to solve a similar problem. Claim 1 recites causing interference in the telephone line while Flood discloses uncoupling the telephone from the telephone network using a switch. Since Flood already discloses a solution to a problem, there is no logical reason to modify Flood to solve the problem using a different solution.

The Applicant also points out that Flood has a different method of operation from the call restrictor of claim 1 and Flood cannot be modified to function in the same manner as the call restrictor recited in claim 1. This is because under MPEP 2143.01, the proposed modification cannot change the principle of operation of a reference. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious. MPEP 2143.01, citing *In re Ratti*, 270 F.3d 810, 123 U.S.P.Q. 349 (CCPA 1959).

Also, the Applicant points out that the omission of an element and retention of the element's function is an indicia of unobviousness. (See MPEP 2144.04 at ¶II B.) The caging system of Flood requires a switch (i.e., a PBX or Class 5 switch) in order to block or control telephone calls. No such limitation is recited in claim 1 which functions even without a switch since the call restrictor of claim 1 uses interference to respond to a call inhibition condition.

Based on the foregoing, Flood does not obviate claim 1. Claim 2, 4, 5, 9, 10 and 11 depend from claim 1 and are allowable for the same reason that claim 1 is allowable. With respect to claim 2, the Examiner states that "because Flood teaches playing a recorded block indication message, it would be obvious for one of ordinary skill in the art to have substituted a 'tone signal' inasmuch as both are merely different variations on an indication signal." (Office Action, p. 4). The Applicant submits that the Examiner has misunderstood the teaching of Flood. The function of the "recorded block indication message" in Flood differs from the tone signal recited in claim 2. In Flood, the "recorded block indication message" serves as an indication signal that the call is to be terminated by the switch. In claim 2, the tone signal functions not as an "indication signal" but as interference in the telephone line.

As to independent claims 12, 19, 20, and 21, the Examiner stated that "the system of Flood has been discussed above" and that Flood "teaches that voice commands, by way of a voice-recognition device or IVR, read as the claimed "remote computer" may be used to program system 100. (Col. 4. lines 8-18)." The Applicant respectfully disagrees with the Examiner. First, for the reasons previously discussed above, the Applicant disagrees with the Examiner's contentions regarding Flood. Further, for the reasons set forth below, the Applicant disagrees with the Examiner's contention that Flood reads on the limitation of a "remote

computer”.

The limitation a “remote computer” is recited only in claim 12 and claim 21 (as amended). Claim 19 has been amended to remove the term “remote computer”. The term “remote” as used in the claims refers to a computer or IVR system that is connected to the public telephone switching network (“PTSN”) via a local exchange that is different from the local exchange of the telephone line on which the call restrictor is connected. See, Specification at page 4, line 4-6 and page 8, lines 1-24. The section of Flood cited by the Examiner refers to a user that is using a telephone keypad (or voice commands over the telephone) to supply telephone access criteria to the call caging system. However, there is nothing in said cited reference that disclose or suggests a computer or IVR system that is “remote”, that is, located on a local exchange that is different from the local exchange of the call caging system. In fact, nothing in Flood discloses or suggests a computer or IVR system that is “remote” from the call caging system. Actually, Flood teaches that all of the elements of the call caging system of Flood connect to the public switch telephone network through the same local exchange. For example, Flood states:

FIG. 1 is a block diagram of a call caging system 100 of the present invention. Call caging system 100 includes a telephone 102, a switch 104, a database 106, and a telephone network 108, which are interconnected by various communication busses. The bus interconnecting telephone 102 and switch 104 is commonly referred to as a “line”. The bus interconnecting switch 104 and network 108 is commonly referred to as a “trunk”. Telephone network 108 is telephone network of conventional design.”

Flood, col. 2, lines 49-59.

As stated by the section of Flood cited by the Examiner, the user “supplies access criteria to call caging system 100 by using commands to call caging system 100 using

telephone 102.” (Flood, col. 4, lines 8-10) The only component of the call caging system that would be able to receive such commands would be the switch. However, as discussed below, the switch of Flood is not located on a different local exchange from that of the other components of the call caging system.

Flood states that the switch is a PBX or a Class 5 switch. (Flood, col. 3, line 1-5) If the switch is a PBX, according to Flood, the PBX can be co-located with the telephone at the user’s location. *Id.* In any case, the PBX connects to the same local exchange as the telephone since it is merely the user’s private switching office and still has to go to the local exchange to access the PTSN. (See, Newton’s Telecom Dictionary 17th Edition [“Newton”] at p. 518.) If the switch is a Class 5 switch, according to Flood, the Class 5 switch is located “remotely” from the telephone. *Id.* However, a “Class 5 switch” is a circuit switch used in an “end office”. An “end office” is merely another term for “local exchange” (“Class 5 switch” – a type of circuit switch used in a local telephone end office. Newton’s Telecom Dictionary 17th Edition [“Newton”] at p. 149; “End Office” – a central office to which a telephone subscriber is connected...The last central office before the subscriber’s telephone equipment. Newton at p. 250; “Local Exchange” – the telephone exchange where subscribers’ lines are terminated. Also called an “End Office”. Newton, p. 410.). Thus, in Flood, a Class 5 switch is not located on a local exchange different from that of the call caging system. Based on the foregoing, Flood does not disclose a “remote” computer, as the term is used in claims 12 and 21.

Claim 19 (as amended) requires among other things, “establishing a connection between a computer and a destination station”, “inputting call restriction data into the computer”, “sending signals representing the inputted call restriction data from the computer”

onto the telephone line”, “storing said call restriction data from the computer in the call restriction device....” The Examiner has not cited any part of Flood or any other reference that discloses, teaches or suggests these limitations.

With respect to claim 20 the Examiner stated that Flood teaches the claimed limitations as discussed earlier in the Office Action. The Applicant disagrees for the same reasons it disagrees with the Examiner’s discussion above regarding Flood. Further, claim 20 requires, among other things, “a converter for converting tone signals on the telephone line into digital signals and converting digital signals from the digital processor into tone signals.” Nothing in Flood discloses, suggests or requires converting digital signals from a digital processor into tone signals.

For the foregoing reasons, claims 12, 19, 20 and 21 are allowable over Flood. Claims 13-15 and claims 22 respectively depend from claims 12 and 21 and are allowable for the same reasons as their dependent claims.

As to claim 16, the Examiner contends that “Flood teaches the claimed limitations as discussed above.” (Office Action, p. 5.) The applicant respectfully disagrees for the same reasons previously discussed above. The Examiner also contends that “Flood further teaches that a user begins using the call caging system 100 by dialing an access number which inherently is accessible via the PSTN. (Col. 6, lines 13-15) *Id.* The Applicant respectfully disagrees. The section of Flood cited by the Examiner merely relates to the user dialing the access telephone number for the call caging service. Nothing in said reference discloses or suggests that said access telephone number is accessed via the PSTN. Moreover, as pointed out by the Applicant in its discussion of claim 12 and 21, all of the components of the call caging system of Flood are connected to the same local exchange. As such there is no reason

for a user to go through the PSTN in order to access the call caging system of Flood.

For the foregoing reasons, claim 16 is allowable over Flood. Claims 17 and 18 and depend from claim 16 and are allowable for the same reasons as their parent claim.

In ¶3 of the Office Action, the Examiner rejected claims 3 and 23-25 under 35 U.S.C. 103(a) as being unpatentable over Flood in view of U.S. Patent No. 6,014,435 to Rosen (hereafter, "Rosen"). The Applicant respectfully traverses this rejection.

As to claim 24, the Examiner states that Rosen "teaches a call defeat apparatus which sends a loud audio/DTMF tone which a telephone system is unable to recognize, thus disrupting communications. (Col. 2, lines 47 - 65 of Rosen)." The Examiner contends that "[I]t would have been obvious to combine the interfering signal of Rosen with the system of Flood because Rosen's method is simply an old and well known way of disrupting communications. While Flood teaches actually disconnecting/terminating a call, either method would be a viable choice and therefore merely a design choice or preference to one of ordinary skill in the art. Furthermore, the use of circuitry in Rosen could easily be implemented using logic control/elements are used in Flood and vice versa. Such is also a design choice or preference to one of ordinary skill in the art."

The Applicant respectfully disagrees on the ground that it would not have been obvious to combine Rosen and Flood since Flood and Rosen take mutually exclusive paths to reach different solutions to solve a similar problem, and therefore, by implication each teaches away from being combining with the other. Rosen discloses using a DTMF or audio tone to prevent calling unauthorized telephone numbers. On the other hand, Flood discloses uncoupling the telephone from the telephone network using a switch. Since Flood and Rosen teach away from

each other, it would not be logical to combine them.

Also, since Flood and Rosen have different methods of operation from each other, neither reference can be modified to function in the same manner as the other. This is because under MPEP 2143.01, the proposed modification cannot change the principle of operation of a reference. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious. MPEP 2143.01, citing *In re Ratti*, 270 F.3d 810, 123 U.S.P.Q. 349 (CCPA 1959).

For the same reasons, it is not obvious to combine Rosen and Flood to render obvious claims 3, 23 and 25. Also, as previously discussed above, Flood does not render claims 1 and 21 obvious as it fails to disclose all the limitations of claim 1 and 21. Thus, it does not render obvious claims 3 and 23 which depend respectively from claims 1 and 21. As such combining Flood with Rosen is still not sufficient to render claims 3 and 23 obvious.

Also, with respect to claim 23 the Examiner states that “inherent in the obvious combination of Flood and Rosen are first and second control signals, the first signal is merely the instruction to send a tone to interfere with communications. If the signal intensity is to be amplified, then of course, a second signal will be sent to notify the system to do this.” (Office Action, p. 7). The Applicant respectfully disagrees. Nothing in Flood discloses or suggests sending any kind of control signal to interfere with communications and nothing in Rosen discloses sending more than one control signal to generate a tone. Based on the foregoing, to state that a first and second signal performing which different functions is “inherent” in the combination of the two references is, at best, a strained interpretation of these references.

For the foregoing reasons, claims 3 and 23-25 are allowable over Flood and Rosen.

In ¶4 of the Office Action, the Examiner rejected claim 6 under 35 U.S.C. 103(a) as being unpatentable over Flood in view of U.S. Patent No. 5,590,182 to Stevens et al. (hereafter, "Stevens".) The Applicant respectfully traverses this rejection. Claim 6 depends from claim 1 and, as discussed above, Flood does not render claim 1 obvious and fails to disclose all of the limitation of claim 1 and consequently, claim 6. Thus, combining Flood with Stevens will still not render claim 6 obvious.

The Examiner also contends that:

What is not specifically taught by Flood is how the system is powered. . . . A common method is taught by Stevens et al. wherein the call restricting control device 1 is connected to the telephone or located within the telephone and is powered like a telephone is. This means that no power is supplied until an off-hook condition is sensed and then the various circuits allow power to be sent to the telephone, and in the case of Stevens et al., to the control device 1 as well. (Col. 5, lines 17-33, Col. 6, lines 46 - 53 of Stevens et al.). It would be obvious for one of ordinary skill in the art to power the invention of Flood in this manner inasmuch as it would merely be a design choice or preference.

Office Action, p. 7. The Applicant respectfully disagrees.

The portions of Stevens cited by the Examiner merely relate to how the device of Stevens operates. In fact, the device of Stevens must be supplied with power in order to detect an off hook condition. For example, Stevens states that "[b]y monitoring the outputs of detector 19 and sensor 25, central processing unit 3 can determine which one of instruments 35 or 47 is 'off-hook'" (Stevens, col 5, line 54 to col. 6, line 1). In order for the detector and sensor to provide outputs and in order for the central processing unit to monitor said outputs, these components must clearly be supplied powered with power even before an off-hook condition is detected or exists. In fact, the device of Stevens is actually powered externally and not powered

like the telephone as the Examiner contends. "Device 1 is powered by power supply distribution regulation device 31 which is in turn powered by external DC power supply 42 through connection 41 and external AC main power supply 43." Stevens, col. 6, lines 39-42.

Based on the foregoing Stevens clearly does not disclose or teach "supplying power to said controller and to said transceiver only when a telephone off hook condition is detected on the telephone line" as required by claim 6. As such the combination of Flood and Stevens does not obviate claim 6.

In ¶5 of the Office Action, the Examiner rejected claims 7 and 8 under 35 U.S.C. 103(a) as being unpatentable over Flood in view of Stevens and further in view of U.S. Patent No. 4,095,056. to Ewen (hereafter, "Ewen"). The Applicant respectfully traverses this rejection.

First, claims 7 and 8 depend from claim 1. As previously discussed above, Flood does not obviate claim 1 and, consequently, any claims that depend from claim 1. Thus, the combination of Flood with Stevens in view of Ewen does not obviate claims 7 and 8.

The Examiner further states that:

Stevens et al. further teach having a predetermined time wherein call blocking is applied to the telephone. And if an off-hook condition is still detected, even if the predetermined time is over, still continuing the apply call blocking. (Col. 10, lines 31 - 49 of Stevens et al.). What Flood and Stevens et al. do not explicitly teach is an on-hook condition of sufficient time. However, Ewen teaches a call restriction apparatus that guards against a user flashing his/her hook switch to trick the apparatus via a time delay circuit which reads on the claimed "maintaining the interference... until a telephone on hook condition of sufficient duration is detected." (Col. 7, lines 22 - 36 of Ewen).

Office Action, p. 8. The Applicant respectfully disagrees. As discussed below, nothing in the section of Ewen cited by the Examiner discloses or teaches maintaining interference until an on

hook condition of sufficient duration is detected. Rather it relates to keeping a set of relays (which do not creates any kind of interference on a telephone line) remain closed until released by a timing circuit.

Ewen states that when a caller who call has been disconnected (i.e., blocked or restricted) hangs up the handset, “[s]tart relay A is de-energized and contacts A6 de-energize restrict relay R and supervisory relay C. The release of these relays is delayed by the timing circuit consisting of the resistor R1 and capacitor C1 to insure that if the caller lifts his handset again before the exchange has released his connection, he will still be disconnected by the R relay.” (Ewen, col. 7, lines 15-21, emphasis added). When the caller attempts to fool the toll restrictor of Ewen by flashing the hook switch, a series of relays and contacts are activated. (Ewen, col. 7, lines 22-32) However, because the supervisory relay C has remained operated because of the time delay circuit, the restrict relay disconnects the caller. (Ewen, col. 7, lines 30-36). Nothing in the foregoing discloses or teaches that said relays maintaining interference on a telephone line or that these relays are released when an on hook condition of sufficient duration is detected.

For the foregoing reasons claim 7 is not obviated by the combination of Flood and Stevens in view of Ewen.

With respect to claim 8, the Examiner contentions relate to the limitation of an “off hook” condition of insufficient duration. The Applicant has amended claim 8 to change this to an “on hook” condition of insufficient duration.